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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,384	04/01/2004	Longin B. Greszczuk	BOE-002P	9372

7590 12/05/2005

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EXAMINER	
BRUNSMAN, DAVID M	

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/816,384	GRESZCZUK, LONGIN B.	
	Examiner	Art Unit	
	David M. Brunsman	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's response filed 08 September 2005 has been carefully considered.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-16, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 1333057.

The reference teaches a coating composition comprising 60 parts paraffin wax (C_{25-30} paraffins, having a melting point of about 120-160 F), 15 parts beeswax (fatty acid esters, having a melting point of about 149 F), 15 parts carnauba wax (fatty acid esters, having a melting point of about 187 F) and, 12 parts coloring matter such as chromium oxide. See page 1, lines 70-75. No bubbles are disclosed in the finished mixture. The reference does not disclose the melting point of the waxes mixed of the melting point of the entire mixture. The rule of mixtures predicts that the melting point of the mixture would be about (.6(160)+.15(149)+.15(187))/0.9=163 F. In combination with the application temperature of the mixture of 212 F (page 2, line 8), it is considered that the melting point of the mixture would fall within the range of *about* 140-180 F. No criticality for compositions exactly falling within the range of 140-180 F is demonstrated in the instant application. However, the similar ingredients employed and manner of use would be expected to exhibit similar physical properties. While the prior art coating composition is intended for a different future use the instant claims are drawn to a composition and its intrinsic physical properties which are not dependent upon the intended use.

Applicant's response argues the patent does not disclose a composition including a powdered metal, metal oxide, or metal carbide. The reference clearly disclose chromic oxid[e] as one of 3 possible coloring matters envisioned as useful. The examiner has not

conceded that "Annan does not teach dispersed powder..." – it does as it explicitly discloses chromic oxide as well as "pigments". The secondary reference is relied upon in the 103 rejection to teach the use of titania and aluminum, in particular. Annan discloses every required feature of the instant claims. Recitation of additional process steps (such as heating the substrate) does not obviate the rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4-7, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 1333057, as applied above, in view of US Patent 5106415.

The difference between US 1333057 and the instant claims is the recitation of the dispersed powder as aluminum metal (comprising particulates of the size 25-60 microns) or titanium dioxide. US 5106415 teaches a formulation for a wax-based coating comprising a powder component of a filler such as 25-150 micron aluminum powder and/or a pigment such as titanium dioxide. (See column 3, lines 3-10, 37-38). It would have been obvious to one of ordinary skill in the art to substitute the aluminum powder or titanium dioxide of US 5106415 for the chromium oxide of 1333057 because the secondary reference teaches they are useful in similar wax-based applications.

The secondary reference teaches the titania and aluminum pigments recited in the instant claims are useful as coloring agents in wax-based coating compositions. There is no evidence of record that the coloring properties of the pigment are reliant or would be expected to be reliant upon the manner by which the wax composition is intended to be applied. Applicant's response cites the MPEP for three possible sources of motivation to

combine references. The combination proposed by examiner meets all three. The nature of the problem to be solved in each reference is how to color a wax composition, Annan teaching pigments such as chromic oxide are effective and Davidian teaching pigments such as titania and aluminum are. The secondary reference clearly teaches that aluminum and titanium pigments are useful for coloring wax-based coating compositions and as such the addition of a pigment such as the titania or aluminum recited is taught by the prior art secondary reference and effective to color wax-based coatings. Physical incorporation of the compositions of the Annan and Davidian references is not required only application of what Davidian teaches one of ordinary skill in the art to the invention of Annan.

Claims 1-20 of this application conflict with claims 1-21 of Application No. 10/766702. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-7, 9 and 11-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 9 and 12-14, respectively, of copending

Application No. 10766702. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The instant claims above differ from the prior art only in the recited intended use and the intrinsic physical property of reduced moisture loss in the intended use. While this property may be best measured during the intended use, the similar compositions employed by the other application would be expected to possess the same physical properties. There is no evidence of record that the compositions claimed in either application are materially limited by the recitation of intended use.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, 9 and 11-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 9 and 12-14, respectively, of copending Application No. 10/766702. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in the recited use. One of ordinary skill in this art understanding the basic chemical and engineering principles of the art and would recognize that a composition designed to seal a porous surface and prevent water absorption thereby would prevent water transport at either interface likewise preventing water loss from a moist substrate. See, *ex Parte Hiyamizu*, 10 USPQ2d 1393.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 8, 10 and 14-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 10 and 15-21, respectively, of copending Application No. 10/766702. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 8 fully encompasses claim 8 of the other application. Claims 14-20 of the instant application differ from claims 15-21 of the 10/766702 application in the range at which the mixture of fatty acid esters and hydrocarbons melt/soften. The ranges overlap between 180 F and 190 F. Without a showing of criticality or unexpected results for the difference in the ranges, product claims having overlapping numerical ranges would have been obvious to one of ordinary skill in the art. *In re Malagari,* 182 USPQ 549.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

With respect to double patenting, applicant's response argues that the application as neither the same nor obvious in view of one another as one is intended to prevent moisture penetration and the other is intended to prevent moisture loss. While the two applications may use a coating composition for a different purpose, a product by process claim is still drawn to the product itself and not limited by the intended future use. Arguments advanced after final rejection, not earlier presented, may be considered untimely.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until

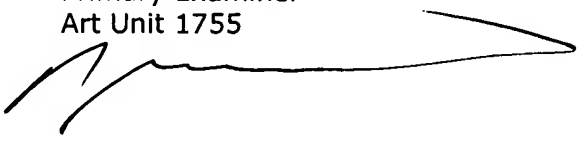
after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755



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